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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/742,914	12/23/2003	Robert I. Shor	3180/3 CIP	7167
23429 7590 12/31/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER				
BUTLER, PATRICK NEAL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/742,914

Applicant(s)

SHOR, ROBERT I.

Examiner

Patrick Butler

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 0208.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkozi (US Patent No. 5,1381,774) in view of Swartz et al. (US Patent No. 6,346,210 B1) and Healy et al. (US Patent No. 5,951,935).

With respect to Claim 1, Sarkozi teaches making a customized insole liner (a method for manufacturing custom fit therapeutic footwear) (see Abstract) by providing a lining element 10 (providing a first insert) (see fig. 3 and col. 3, lines 22-27), forming openings 15, 16, 17 through layers 12, 14 where support is needed (forming an area of reduced thickness in the first insert corresponding to the at least one of the high pressure areas) (see col. 2, lines 26-30 and col. 3, line 64 through col. 4, line 6), providing a base pad 25 into the lining element 10 (providing a mass of a second insert material; partially filling the area of reduced thickness in the first insert with a mass of the second insert material to thereby provide a custom molded insert with accommodation) (see col. 4, lines 43-46). Since Sarkozi adjusts as the pads of the lining element based on the patient's foot (see col. 2, lines 26-30), the patient's foot is measured.

Sarkozi does not expressly teach imprinting a patient's foot to identify a patient's footprint and high pressure areas on the bottom of the foot, that the lining element 10 is multidensity and fabricated from a mold of the foot, and that the base pad 20 is a softer hardness than the first insert material.

Swartz teaches making a foot pad 50 with different densities by imprinting the foot against the foam (the lining element 10 is multidensity and fabricated from a mold of the foot; imprinting a patient's foot to identify a patient's footprint and high pressure areas on the bottom of the foot) (see abstract; fig. 3; and col. 6, lines 44-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Swartz's method to make adjustable Sarkozi's lining element 10 in order to absorb shock (see Swartz, col. 6, lines 44-50).

Healy teaches to provide a sock liner member 30 with elastomeric pads 32, 34 that are softer than the sock liner member 30 (the base pad 20 is a softer hardness than the first insert material) (see col. 2, lines 36-46 and col. 3, lines 8-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to Healy's softer elastomeric pads as the base pad 25 of Sarkozi in order to have excellent cushioning, shock absorption, and energy return (see Healy, col. 1, lines 25-34).

With respect to Claim 2, Sarkozi teaches to use the insole liner for shoes (inserting the custom fit inserts into a shoe) (see abstract).

With respect to Claim 3, Sarkozi teaches that the layers 13, 14 of the lining element 10 are $\frac{1}{64}$ " - $\frac{1}{4}$ " thick before forming an opening and thus removing a layer in

that area (see col. 3, lines 40-41 and line 64 through col. 4, line 6), which would be a thickness reduction of $(\frac{1}{64})/(\frac{1}{64} + \frac{1}{4})$ to $(\frac{1}{4})/(\frac{1}{64} + \frac{1}{4})$ or 6-94%, which reads on the claimed reduction of 75%.

Alternatively, if it is held that Sarkozi does not appear to explicitly teach that thickness reduction is within the claimed range (e.g., about 75%), in this regard, Sarkozi teaches providing liner element 10 layer thickness sufficient to allow insertion and retention of the base pads (see col. 3, lines 40-45). As such, Sarkozi recognizes that the thickness of the liner element 10's layers is a result-effective variable. Since the thickness of the liner element 10's layers is a result-effective variable, one of ordinary skill in the art would have obviously been motivated to determine the optimum the thickness of the liner element 10's layers applied in the process of Sarkozi through routine experimentation based upon the need to insert and hold an appropriate base pad.

With respect to Claim 4, Sarkozi teaches that the layers 13, 14 of the lining element 10 (first insert material) are $\frac{1}{64}$ " - $\frac{1}{4}$ " thick before forming an opening and thus removing a layer in that area (see col. 3, lines 40-41 and col. 3, line 64 through col. 4, line 6), which would provide for a composite of $\frac{1}{32}$ " - $\frac{1}{2}$ " given the negligible size of layers 11 and 12 (see fig. 3), which reads on the claimed thickness of about $\frac{5}{8}$ inch. Sarkozi teaches that the stack of removable pads 25, 26 (second insert material) is $\frac{1}{64}$ " - $\frac{1}{2}$ " (see col. 4, lines 56-61), which reads on the claimed thickness of about $\frac{1}{16}$ inch.

With respect to Claim 5, Sarkozi teaches that the lining element 10 (first insert) is made of polyethylene (see col. 3, lines 22-45) and that the base pads (second insert material) are made of foam polyurethane (see col. 6, lines 19-32).

With respect to Claim 6, Sarkozi teaches forming openings 15, 16, 17 in the lining element through bottom layers 12, 14 (reduced thickness is formed by abrading a selected portion of the first insert material with an abrasive) (see col. 3, line 64 through col. 4, line 2).

With respect to Claims 7 and 8, Sarkozi teaches that the openings have smaller surface area than the cavities filled by the base pad (adding a pad around the area of reduced thickness) (see col. 4, lines 2-6), that the pads 25, 27 may be made from the same material as the lining element 10 (first insert material) (see col. 6, lines 19-32), and that the stack of removable pads 25, 26 (a pad of said first insert material) is $\frac{1}{64}$ " - $\frac{1}{2}$ " (see col. 4, lines 56-61), which reads on the claimed thickness of about $\frac{1}{8}$ inch. To clarify, one of the pads 25, 27 may be considered one of the second insert and the pad around the area of reduced thickness. Furthermore, the other of the pads 25, 27 would be considered the other of the second insert and the pad around the area of reduced thickness.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkozi (US Patent No. 5,1381,774) in view of Swartz et al. (US Patent No. 6,346,210 B1) and Healy et al. (US Patent No. 5,951,935) as applied to Claim 1-8 above and further in view of Scholl (US Patent No. 1,725,021).

With respect to Claim 10, Sarkozi teaches to use the insole liner for shoes (inserting the custom fit inserts into a shoe) (see abstract). Sarkozi does not expressly teach tracing an outline of the patient's foot on the imprint, sizing a shoe based on the outline of the patient's foot and selecting a manufactured shoe to fit the patient's foot.

Scholl teaches using a pencil to trace the outlines of the foot (tracing an outline of the patient's foot on the imprint) (see page 2 of text, lines 78-94).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to trace as taught by Scholl on the imprint of Sarkozi in order to depict, as nearly as possible, the outline of the foot for which the shoe is intended in order that the last may be made to substantially conform to the configuration of the foot for a shoemaker (sizing a shoe based on the outline of the patient's foot and selecting a manufactured shoe to fit the patient's foot) (see page 1 of text, lines 19-21 and 58-64).

Claims 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarkozi (US Patent No. 5,1381,774) in view of Swartz et al. (US Patent No. 6,346,210 B1) and Healy et al. (US Patent No. 5,951,935) as applied to Claim 1-8 above and further in view of Brown (US Patent No. 3,995,002).

With respect to Claim 9, Sarkozi teaches making an insert as previously described. Sarkozi does not appear to expressly teach the steps of forming a mold of a lower portion of the patient's foot and forming a cast of the lower portion of the patient's foot from the mold.

Brown teaches to product a negative mold of a foot to produce a positive form (forming a mold of a lower portion of the patient's foot and forming a cast of the lower portion of the patient's foot from the mold) (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Brown's method of forming a negative and then positive mold with Sarkozi's method of making an insert in order to allow the insert to be made in accordance with a doctor's prescription (see col. 1, lines 51-61).

With respect to Claim 11, Sarkozi teaches making an insert as previously described and teaches cutting the pads from larger pads (providing a sheet of the second insert material which is cut to fit into the area of reduced thickness in the first insert material) (see col. 6, lines 6-18). As Sarkozi is combined with Swartz, Swartz teaches contouring the laminate construction 20 (first insert) by pressing against the foot 24 (see fig. 3 and col. 6, lines 11-19) but does not appear to expressly teach vacuum forming the first insert material.

Brown teaches molding against a patient's foot by vacuum molding (see fig. 3 and col. 1, line 65 through col. 2, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Brown's vacuum molding technique in the process of Sarkozi as modified by Swartz pressing of the laminate in order to provide an better insert by preventing the formation of skin wrinkles across the critical area of the midtarsal joint and decompressing the soft tissue deformation (see Brown, col. 9, lines 16-21).

With respect to Claims 12 and 13, Sarkozi, as combined with Swartz and Healy, teaches making an insert as previously described. Sarkozi teaches making a customized insole liner by forming openings 15, 16, 17 through layers 12, 14 where support is needed (evaluating a patient's foot) (see fig. 3; col. 2, lines 26-30; col. 3, lines 22-27; and col. 3, line 64 through col. 4, line 6).

Sarkozi does not appear to expressly teach the steps of forming a mold of a lower portion of the patient's foot and forming a smooth cast of the lower portion of the patient's foot from the mold.

Brown teaches to product a negative mold of a foot to produce a positive form (forming a mold of a lower portion of the patient's foot and forming a smooth cast of the lower portion of the patient's foot from the mold) (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Brown's method of forming a negative and then positive mold with Sarkozi's method of making an insert in order to allow the insert to be made in accordance with a doctor's prescription (see col. 1, lines 51-61).

The steps' locations are necessarily met since the office is not distinguished from the laboratory in requirements of being different of location or structure. Moreover, Brown teaches forming the insert upon the instruction of the doctor's prescription and mold, which would provide manufacturing in a manufacturing laboratory setting (wherein steps a, b, c, and i are performed in the office of a licensed professional practitioner and steps d, e, f, g, and h are performed in a laboratory for manufacturing custom fit inserts) (see col. 1, lines 16-23).

Response to Arguments

Applicant's arguments filed 15 October 2008 have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 USC § 103(a) rejections. Applicant's arguments appear to be on the grounds that:

1) In developing a therapeutic shoe, one would not turn to socks and height adjustable stackable support pads.

2) The step of partially filling the area of reduced thickness has not been met by references as applied.

3) Claims 12 and 13's limitations of location for steps are not met by the references as applied.

4) The invention as a whole is not probably in view of the cited references' range of ages except by the use of Applicant's invention as a blueprint.

The Applicant's arguments are addressed as follows:

1) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., making a shoe rather than broadly claiming footwear) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

1) In response to applicant's argument that Swartz's padded insole and Healy's padded sock liner member are nonanalogous art, it has been held that a prior art

reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the claimed invention pertains to padded footwear and padded shoe components, all references pertain to padded footwear and padded shoe components, and the references solve the same problem as the invention of padding feet in footwear.

2) The step of partially filling the area of reduced thickness is taught by Sarkozi's teaching of providing a base pad 25 into the lining element 10 (see col. 4, lines 43-46).

3) As recited above, the steps' locations are necessarily met since the office is not distinguished from the laboratory in requirements of being different of location or structure. Moreover, Brown teaches forming the insert upon the instruction of the doctor's prescription and mold, which would provide manufacturing in a manufacturing laboratory setting (wherein steps a, b, c, and i are performed in the office of a licensed professional practitioner and steps d, e, f, g, and h are performed in a laboratory for manufacturing custom fit inserts) (see col. 1, lines 16-23).

3) Given the broad limitations of the claimed terms "office" and "lab," they are indistinguishable from the setting of the prior art. It is noted that there is no claimed steps of shipment or transit. Thus, the terms do not preclude all steps being done at one location.

3) Moreover, The limitation of the steps location in a office and laboratory appear to be "wherein" clauses to the extent that the evaluation etc. are considered to be done

in an office because of the nature of the transaction of customer interaction and the production etc. are considered to be done in a laboratory because of the manufacturing-nature of their production. Thus, this "wherein" clause simply constitutes a restatement or result of the positively claimed steps preceding it. See MPEP § 2114.04.

4) The mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem. See MPEP 2145(VIII).

4) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791